REMARKS

At least entry of the claim amendments is respectfully requested for purposes of appeal, because by expressly defining "devolve" in the claims, the claims are in better form for appeal and/or appeal issues are simplified. MPEP 714.13 and 1207, provide that an amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt Examiner suggestion. It is believed that by expressly defining "devolve" in the claims, an appeal issue as to the meaning of "devolve" is simplified. The Examiner in the previous Office Actions and during the Examiner interviews on record maintains that the term "devolve" may be interpreted broadly as a simple transfer, thereby could read on Ross (e.g., final Office Action, page 4(c); Advisory Action mailed October 16, 2003). Therefore, the claim amendments clarify this issue surrounding the term "devolve," and clearly place the application in better condition for appeal. The amendments were not previously submitted, because of good faith believe that the term "devolve" in the context of the recitation of the claims clearly conveys passing down license rights from one to another via degeneration and that Ross and Hasebe did not disclose the present invention as previously claimed. Therefore, the Examiner should enter the claim amendments.

Further, entry and reconsideration of the claims is respectfully requested, because it is believed that the claim amendments clarify the patentably distinguishing features of the present invention for allowance, and the claim amendments should not entail any further search by the Examiner since no new issues are being raised. For example, dependent claim 7 as amended is clearly patentably distinguishing over Ross and Hasebe.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered" (Underlining added for emphasis). Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Otherwise, the Applicants request withdrawal of the finality of the May 19, 2003 Office Action and reopen prosecution for express consideration of the claim amendments that clarify the patentably distinguishing features of the present invention by defining the term "devolve."

This Substitute Amendment After Final substitutes the After Final Amendment filed September 17, 2003, which the Examiner did not enter.

STATUS OF CLAIMS

Claims 1-9 are pending.

The Examiner maintains from the previous Office Action the rejections of pending claims 1-9 under 35 USC 103(a) as being unpatentable over Ross (US Patent No. 5,553,139) in view of Hasebe (US Patent No. 5,392,351).

Claims 1, 2, 7, 8, and 9 are amended, and, thus, claims 1-9 remain pending for reconsideration, which is respectfully requested.

No new matter has been added in this Amendment. The foregoing rejections are hereby traversed.

CLAIMED INVENTION

Independent claims 1, 8 and 9 are amended to expressly recite in the claims a definition of "devolve." Support for the claim amendments can be found throughout the specification (e.g., page 16, line 16 to page 18, line 17) as well as in the attached dictionary definitions, which are 12 English definitions of the terms "devolution," "devolve," "degeneration," and "degenerate" from several popular online and print English dictionaries and thesauruses.

The claim amendments define "devolve" in the context of passing down license rights from one to another via degeneration. Accordingly, the claims now expressly differentiate from Ross, because Ross simply does not disclose or suggest,

> reading the second media ID and encrypting the key and a second license information, ~~representing~~ that represents a second right to use the contents ~~that is~~ devolved from the first license information stored on the first storage medium by passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium, together with one another or individually, with the read second media ID, to generate a second encryption secure information with the second media ID for storage in said second storage medium (claim 1).

Ross does not disclose or suggest the claimed license devolution apparatus of the present invention, because Ross relates to a license distribution technique, which differs from the present invention's license devolution between two storage media. In particular, Ross does not

disclose or suggest, (1) "passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium," and (2) "degenerating the first license information in the first storage medium." In other words, Ross does not disclose or suggest the present invention's license devolution operations as recited, for example, in dependent claims 2, 3, 5 and 6, which include degeneration of the first license information into third encryption secure information stored in the first storage medium, and storage of a devolved second license information in the second storage medium by passing down the first license information to the second storage medium as a successor of the first storage medium.

More particularly, the present invention as recited in amended independent claim 8 recites:

> storing in a first storage medium contents encrypted with a predetermined key, a first media ID identifying the first storage medium, and ... encrypting with the first media ID, the key and a first license information, which represents a right to use the contents;
>
> ...
>
> generating a second encryption secure information by reading a second media ID identifying a second storage medium and encrypting with ~~a~~the read second media ID, ~~which identifies a second storage medium,~~ the key and a second license information, which represents a second right to use the contents that is devolved from the first license information stored on the first storage medium by passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium; ...

Ross does not disclose or suggest the present invention's license devolution from one storage medium to another storage medium by "passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium."

The Examiner also relies on Pinard (US Patent No. 5,638,494) and Stefik (US Patent No. 5,715,403) (page 11 of the final Office Action) to assert that "devolution" is old and well known. The Applicants respectfully disagree, because the claimed idea of the invention is devolving license rights from one storage medium to another storage medium and using media IDs of the transferor storage medium and the transferee storage medium to protect the devolved license rights, respectively, which is not disclosed or suggested either alone or by combination of Ross, Hasebe, Pinard and Stefik.

The claimed invention has the following benefits: (1) allow secure/legal copying of content from one to another, because the license is devolved using media IDs of transferor and transferee; (2) copying content/information for a number of times via media ID devolution, and prohibiting further copying of the content beyond the number times, which can be used to accommodate free use of the content/information for one hundred times by any user; and (3) using the content/information for fifty times out of the one hundred in one computer and to media ID devolve the right of using the content for the other fifty times in another computer.

DEPENDENT CLAIM 2

To reject dependent claim 2, the Examiner relies on Ross, FIG. 2, operations 210 and 218, and FIG. 5, (any of 2-4 would be considered as third user of the third right of using and obtained by eliminating/subtracting the second right of using from the first right of using) (page 5 of the final Office Action). Ross' operation 218 encrypts the encrypted portion of the license with an OEM transit password, where in FIG. 5, the OEM is one of the entities (2-4) down the distribution chain from the manufacturer 1. However, Ross' operation 218 does not perform the present invention's claim 1 recitation, "passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium." Therefore, Ross does not disclose or suggest the amended claim 2 recitation, "said encryption means degenerates the first license information by encrypting ~~encrypts~~ with the first media ID a third license information ... to generate a third encryption secure information and stores the third encryption secure information in the first storage medium."

Therefore, dependent claim 2 recites how the first license information is degenerated to generate a "third encryption secure information in the first storage medium," for example, by "subtracting the second license information from the first license information (claim 2)," or "encrypts with the first media ID both the key and a third right of using" (claim 2). Even if one applied the Examiner's rationale to Ross, so that the entities down the distribution chain in Ross (2-4 in FIG. 5), such as the installer, correspond to a second or third storage medium with the disabled license relative to the manufacturer's first storage medium. However, Ross is completely silent on performing the present invention's "degenerating the first license information in the first storage medium" (claim 1 and 2), because as the Examiner admits that if Ross provides a third encryption secure information as the disabled license at the installer, the disabled license is stored down the distribution chain in the third storage medium relative to the manufacturer's first storage medium, which differs from the present invention's "third encryption

secure information in the first storage medium." In Ross, in the Examiner's alleged first storage medium of the manufacturer (entity 1 in FIG. 5), Ross does not perform the present invention's degeneration of the license in the first storage medium to generate "third encryption secure information in the first storage medium."

DEPENDENT CLAIMS 3, 5 AND 6

Dependent claims 3, 5 and 6 that depend from claim 2 recite other examples of the present invention's "degenerating the first license information in the first storage medium."

For example, dependent claim 3 recites that "first encryption secure information stored in the first storage medium is destroyed," if entire rights are devolved to the second storage medium. And dependent claim 5 recites, "third license information represents the absence of the right to use." To reject dependent claims 3 and 5, the Examiner asserts that Ross' disabled license for entities down the distribution chain is similar to the present invention's "third license information." However, the present claimed invention as recited in dependent claim 2 provides: "degenerates the first license information by encrypting ~~encrypts~~ with the first media ID a third license information ... to generate a third encryption secure information and stores the third encryption secure information in the first storage medium." Therefore, in the present invention the third license information is the degenerated first license information stored in the first storage medium. Even if one applied the Examiner's rationale to Ross, so that the entities down the distribution chain, such as the installer, correspond to a second storage medium with the disabled license relative to the manufacturer's first storage medium. Therefore, Ross' first storage medium (manufacturer) does not store the present invention's "third encryption secure information," in which the present invention "degenerates the first license information by encrypting ~~encrypts~~ with the first media ID a third license information ... to generate a third encryption secure information and stores the third encryption secure information in the first storage medium."

Further, dependent claim 6 recites, "the third license information represents a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time." The Examiner relies on inherency to reject dependent claim 6, but Ross does not disclose or suggest the present invention's "third encryption secure information," which is a degenerated "first license information" and stored in the first storage medium.

DEPENDENT CLAIM 7

Dependent claim 7 is amended to clarify another configuration of the present invention, in which the license devolution apparatus is configured as a composite storage unit to devolve a license from the first storage medium to the second storage medium, as shown in FIG. 1. Clearly dependent claims 7 recites allowable features, because Ross does not relate to, or disclose or suggest, "a composite storage unit." In particular, in contrast to Ross and Hasebe, the claimed invention as recited in amended dependent claim 7, provides:

> wherein the first and second storage media form a composite storage unit, the composite storage unit further comprising a first drive and a second drive driving the first storage medium and the second storage medium, respectively, said first drive and said second drive having a first firmware and second firmware accessing the first storage medium and the second storage medium, respectively,
>
> wherein said decoding means and said encryption means are arranged ~~in~~as a composite unit firmware including said first firmware and said second firmware ~~in form of a composite unit~~; and
>
> wherein only said first firmware has authority to access the first storage medium driven by said first drive, and only said second firmware has authority to access the second storage medium driven by said second drive.

The Examiner does not provide a rationale for rejecting the present invention's license devolution apparatus configured as a composite storage unit (see, pages 7-8 of the Office Action). Clearly, Ross and Hasebe do not disclose a composite storage unit, which performs license devolution using the composite unit's first and second storage mediums. Clearly, therefore, dependent claim 7 is allowable. Support for the claim amendments can be found, for example, on page 24, lines 22-23 of the present Application.

CONCLUSION

In view of the claim amendments and the remarks, withdrawal of the rejections of claims 1-9, and allowance of claim 1-9 is respectfully requested. At least entry of the claim amendments is respectfully requested for purposes of appeal, because by expressly defining "devolve" in the claims, the claims are in better form for appeal and/or the appeal issues are simplified.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Respectfully submitted,
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